

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

I. Status of the Claims

Claims 23, 26-31, and 36-38 are pending and subject to examination on the merits.

II. Claim Rejections - 35 U.S.C. § 103

Claims 23, 26-31, and 36-38 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Nos. 6,085,576 and 6,839,636 to Sunshine *et al.* each in view of U.S. Patent No. 6,495,892 to Goodman *et al.* These rejections are maintained from the prior Office Action. In response to Applicants' prior remarks, the Examiner states, *inter alia*, that "Figure 13 and column 18, lines 21-41 of Goodman which teaches an embodiment having one sensor covered by a material that allows the analyte to contact the sensing element and another sensor covered by a material that prevents the analyte from contacting the sensing element." Office Action at pg. 4. Applicants respectfully traverse these grounds of rejection.

The rejections should be withdrawn because the '576 and '636 patents are excepted under 35 U.S.C. §103(c). The Office has not proven that either the '576 or the '636 patents would qualify as a reference under any subsection of 35 U.S.C. §102 (e.g., 35 U.S.C. § 102(b)) that would preclude the application of 35 U.S.C. §103(c).

For the sake of argument only, at best, the '576 and '636 patents may nominally qualify as prior art under only U.S.C. § 102(e). That is so because the '576 and '636 patents were published on 11 July 2000 and 4 January 2005, respectively, which is *after* the effective filing date of the pending claims, 15 November 1999.

The '576 and '636 patents, however, are not cited as anticipatory references. Rather, they are the primary references as part of a § 103 obviousness combination. And 35 U.S.C. § 103(c)(1) states as follows:

Subject matter developed by another person, *which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section* where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c)(1) (emphasis supplied).

This provision applies in this case. Both the '576 and '636 patents were assigned to Cyrano Sciences, Inc. ("Cyrano") by the named inventors. According to Office records, these assignments can be found at reel/frame 010730/0136 for the '576 patent and reel/frame 011223/0403 for the '636 patent. Likewise, the present application was also assigned to Cyrano (reel/frame 012092/0260). Thus, the '576 and '636 patents and this application were "owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c). The '576 and '636 patents, therefore, "shall not preclude patentability."

Even if the '576 and '636 patents were effective prior art, neither of the combinations cited by the Office render the claims at issue obvious for the reasons identified in Applicants' last response. In sum, there is no objective reason to modify the '576 and '636 patents with Goodman's Figure 13 embodiment, and such a modification would change the principle of operation of the '576 and '636 patents.

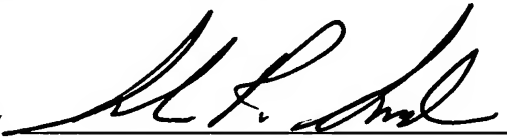
For at least these reasons, Applicants respectfully request reconsideration and withdrawal of these grounds of rejection.

CONCLUSION

Applicants believe that the present application is in condition for allowance. Favorable reconsideration is requested, therefore. Also, Examiner Handy is invited to contact the undersigned directly, should any issue warrant further consideration.

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 C.F.R. §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany the response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, then Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of the relevant fee(s) from the deposit account.

Respectfully submitted,

By 

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FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4758
Facsimile: (202) 672-5399

Shaun R. Snader
Attorney for Applicant
Registration No. 59,987